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Dated: March 26, 2003

Signature:

Shawn P. Foley
(SHAWN P. FOLEY)



Docket No.: EGYPT 3.9-017 CONT
(PATENT)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Delmas et al

Application No.: 10/038,192

Group Art Unit: 1641

Filed: January 2, 2002

Examiner: G. Counts

For: METHODS AND KITS FOR DIAGNOSING
OR MONITORING SYNOVIAL OR
OSTEOARTICULAR DISEASE, COMPRISING
THE USE OF A SPECIFIC MARKER FOR
SYNOVIAL TISSUE DEGRADATION

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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, DC 20231

Dear Sir:

This is in response to the Office Communication mailed February 24, 2003.

REMARKS

Claims 1-31 have been restricted into nine groups, enumerated I-IX. The allegations are that the claims in groups I-VIII are unrelated in that they have different purposes and are independent and distinct inventions. The claims in Groups I-VIII and IX are alleged as related as product and process of use, in that the product could be used in a materially different process such as the method of Group I, and that the product could also be used in the materially different methods of inventions II-VIII.

In response to the restriction requirement, Applicants hereby elect Group I containing claims 1, 2, 10, 11, 13-21, 24, 29 and 30. This election is made with traverse. Claims 1 and 3-9 each recite bringing a biological sample from an individual into contact, *in vitro*, with a means for measuring a specific marker of synovial disease, and determining the level of the

specific marker. Thus, it would certainly appear that the searches for Groups I-VI would be fairly co-extensive, based simply on these common recitations. These similarities would also indicate that the inventions are "related" and could, in fact, be used together, especially since differences in claims of the respective groups pertain to the nature of the information gleaned from the comparison of the level of the marker with a reference level. Moreover, paragraph 4 in the specification teaches that since synovial tissue can be one of the first tissues to be attacked in osteoarticular disease, a specific marker for synovial disease can constitute an early or pre-symptomatic marker for osteoarticular disease as well. Clearly then, the claims in Groups II-VI are related to the claims of Group I.

The claims in Groups VII and VIII (*i.e.*, claims 9, 22 and 23) each pertain to monitoring degradation of synovial collagen. As explained in paragraph 4 on page 1 of the specification, measuring degree of degradation of synovial collagen enables diagnosis or evolution of synovial or osteoarticular diseases. Thus, these two groups would appear to be related to Groups I-VI.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the restriction requirement, at least insofar as it pertains to Groups I-VIII. Thus, Applicants respectfully request that claims 1-30 be grouped together for examination purposes in this patent application. The examiner is encouraged to contact the undersigned if he has any questions.

In the event any fee is due in connection with the present response, the Examiner is authorized to charge Applicant's Deposit Account No. 12-1095 therefor.

Dated: March 26, 2003

Respectfully submitted,

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